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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/007,038	12/04/2001	Glenn R. Bowers	60116P1	2458

22847 7590 12/23/2004

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EXAMINER

KUBELIK, ANNE R

ART UNIT	PAPER NUMBER
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1638

DATE MAILED: 12/23/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/007,038

Applicant(s)

BOWERS ET AL.

Examiner

Anne R. Kubelik

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 04 October 2004.
- 2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-5,8,14,16,17,36 and 37 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-5,8,14,16,17,36 and 37 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: \_\_\_\_\_.

### **DETAILED ACTION**

1. Claims 1-5, 8, 14, 16-17 and 36-37 are pending.
2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
3. The rejection of claim 36 under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter that Applicant regards as the invention is withdrawn in light of applicant's amendment of the claim.
4. The rejection of claims 1-5, 8, 14, 16-17 and 36-37 under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103 as obvious over Rhodes (1999, US Patent 5,942,666) is withdrawn in light of Applicant's presenting a comparison of the relative maturity of both the cultivar of '666 and the instant soybean to Asgrow A5547.

### ***Claim Rejections - 35 USC § 112***

5. Claims 14 and 16 remain rejected under 35 U.S.C. 112, first paragraph, as containing subject matter that was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The rejection is repeated for the reasons of record as set forth in the Office action mailed 20 April 2004, as applied to claims 8, 14 and 16. Applicant's arguments filed 4 October 2004 have been fully considered but they are not persuasive.

Applicant urges that claims 14 and 16 are drawn to a tissue culture of regenerable cells obtained from the plant produced by growing the deposited seed or from a plant with all the

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characteristics of that plant; as the regenerable cells contain the same genetic make-up as that described and enabled plant there is no need to describe the second parent (response pg 4).

This is not found persuasive because the claims are drawn tissue culture produced from soybean seeds from the plant produced by growing the deposited seed or from a plant with all the characteristics of that plant. The second parent of the seed used to produce the tissue culture is not described. Thus, the tissue culture produced from the seed is not defined by genomic structure or by phenotypic characteristics, and therefore, the claimed invention lacks an adequate written description.

***Claim Rejections - 35 USC § 102 - 35 USC § 103***

6. Claims 1-5, 8, 14, 16-17 and 36-37 remain rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103 as obvious over Luzzi (2000, US Patent 6,084,159). The rejection is repeated for the reasons of record as set forth in the Office action mailed 20 April 2004. Applicant's arguments and the Declaration of Dr. Glenn Bowers, both filed 4 October 2004, have been fully considered but they are not persuasive.

Applicant and The Declaration urge that the relative maturity data of soybean of '129, as shown in that patent, in comparison to other varieties, indicates that it has a relative maturity of 6.0 and 6.1, which corresponds to its marketing name, which they state has the relative maturity in it. They urge that S52-U3 has a earlier relative maturity (5.2) (response pg 5-6; Declaration ¶2-4).

This is not found persuasive. The fallacy of Applicant's reliance on marketing name to determine relative maturity is shown in Table 1 of '129. In that table, two varieties (Asgrow

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A5959 and Asgrow AG5901) whose marketing name would indicate a relative maturity of 5.9 have mature at 39.10 and 40.90 days respectively, which according to applicant's explanation (see Declaration ¶2) would mean the varieties should have relative maturities differing by two tenths. Furthermore, Asgrow AG5801, whose marketing name would indicate a relative maturity of 5.8, matures at the same time as Asgrow A5959. Thus, the only way to determine if the relative maturities of any two soybean varieties of the same maturity group are actually different is to grow them side-by-side or in comparison to the same standard. It is noted that '129 states that the Maturity group of that cultivar is V (column 5, line 44).

### *Conclusion*

7. **THIS ACTION IS MADE FINAL.** See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Anne R. Kubelik, whose telephone number is (571) 272-0801. The examiner can normally be reached Monday through Friday, 8:30 am - 5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Amy Nelson, can be reached at (571) 272-0804. The central fax number for official correspondence is (571) 273-8300.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to (571) 272-0547.

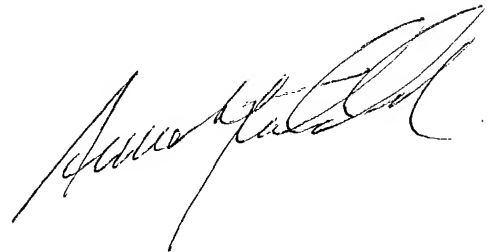
Patent applicants with problems or questions regarding electronic images that can be viewed in the Patent Application Information Retrieval system (PAIR) can now contact the USPTO's Patent Electronic Business Center (Patent EBC) for assistance. Representatives are available to answer your questions daily from 6 am to midnight (EST). The toll free number is (866) 217-9197. When calling please have your application serial or patent number, the type of

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For all other customer support, please call the USPTO Call Center (UCC) at 800-786-9199.

Anne R. Kubelik, Ph.D.  
December 21, 2004

A handwritten signature in black ink, appearing to read 'Anne R. Kubelik', written in a cursive style.

**ANNE KUBELIK  
PATENT EXAMINER**